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10/629,905	07/30/2003	Michael S. Battaglia	2694-211	6233

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/629,905	BATTAGLIA ET AL.	
	Examiner	Art Unit	
	Christopher Onuaku	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/10/03; 8/3/04 & 1/7/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7 recites the limitation " ... wherein said processing circuitry is operable to edit image data stored on said removable memory module .... ". The Specification fails to disclose an "edit" function.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,658,202.

Regarding claim 1, claim 1 of the U.S. Patent No. 6,658,202 cite the features of claim 1 of this application including for use in transferring image data between a removable digital memory module and a user's computer, a portable, hand-held, digital camera picture image data transfer and repository device embodied in a housing connectable to both a removable memory module and a user's notebook or desktop computer and which is of a size which can be held in a user's palm, said repository device comprising a housing of a size to be held in the palm of a user's hand and including a memory input port sized to receive a digital camera memory and including an output port for coupling said portable repository device to a user's computer, a mass storage device operatively coupled to receive and store picture image data from a digital camera memory module inserted into said memory input port and for storing said image data, said mass storage device being accessible for downloading said image data to a user's computer, processing circuitry for controlling the transfer of data stored in said digital camera module inserted into said memory input port to said mass storage device, an output interface, coupled to said mass storage device, for use in transferring

image data stored in said mass storage device to said user's computer, said output interface being compatible with an interface of said user's computer (see lines 1-22).

Claim 1 of current application is obvious over claim 1 of U.S. Patent No. 6,658,202 because claim 1 of current application is broader than claim 1 of U.S. Patent No. 6,658,202. Allowance of claim 1 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 1, therefore obviousness type double patenting is appropriate.

5. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,658,202.

Regarding claim 2, claim 2 of the U.S. Patent No. 6,658,202 cite the features of claim 2 of this application including wherein said processing circuitry is operable to reformat a digital camera memory module inserted into said memory input port to place said digital camera memory module into a state where it can be reused in the user's digital camera for picture capture without erasing desired picture image data (lines 1-6).

Claim 2 of current application is obvious over claim 2 of U.S. Patent No. 6,658,202 because claim 2 of current application is broader than claim 2 of U.S. Patent No. 6,658,202. Allowance of claim 2 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 2, therefore obviousness type double patenting is appropriate.

6. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,658,202.

Regarding claim 3, claim 3 of the U.S. Patent No. 6,658,202 cite the features of claim 3 of this application including wherein said output interface includes a USB interface operatively coupled to said mass storage for transferring oicture image data to a user's computer (lines 1-4).

Claim 3 of current application is obvious over claim 3 of U.S. Patent No. 6,658,202 because claim 3 of current application is broader than claim 3 of U.S. Patent No. 6,658,202. Allowance of claim 3 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 3, therefore obviousness type double patenting is appropriate.

7. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,658,202.

Regarding claim 4, claim 1 of the U.S. Patent No. 6,658,202 cite the features of claim 4 of this application including wherein said processing circuitry in determining that the copy operation has been correctly performed is operable to determine whether the data stored in the memory module conforms with a standard format (lines 1-5).

Claim 4 of current application is obvious over claim 1 of U.S. Patent No. 6,658,202 because claim 4 of current application is broader than claim 1 of U.S. Patent No. 6,658,202. Allowance of claim 4 would result in an unjustified

time-wise extension of the monopoly previously granted for the invention defined by patent claim 1, therefore obviousness type double patenting is appropriate.

8. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,658,202.

Regarding claim 5, claim 6 of the U.S. Patent No. 6,658,202 cite the features of claim 5 of this application including a display device for displaying picture image data (lines 1-3).

Claim 5 of current application is obvious over claim 6 of U.S. Patent No. 6,658,202 because claim 5 of current application is broader than claim 6 of U.S. Patent No. 6,658,202. Allowance of claim 5 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 6, therefore obviousness type double patenting is appropriate.

9. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,658,202.

Regarding claim 6, claim 6 of the U.S. Patent No. 6,658,202 cite the features of claim 6 of this application including a display device for displaying picture image data, wherein said data repository device is operable to receive digital image data from a user's computer (lines 1-4).

Claim 6 of current application is obvious over claim 6 of U.S. Patent No. 6,658,202 because claim 6 of current application is broader than claim 6 of U.S. Patent

No. 6,658,202. Allowance of claim 6 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 6, therefore obviousness type double patenting is appropriate.

10. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,658,202.

Regarding claim 10, claim 8 of the U.S. Patent No. 6,658,202 cite the features of claim 10 of this application including wherein said mass storage device is removable (lines 1-3).

Claim 10 of current application is obvious over claim 8 of U.S. Patent No. 6,658,202 because claim 10 of current application is broader than claim 8 of U.S. Patent No. 6,658,202. Allowance of claim 10 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 8, therefore obviousness type double patenting is appropriate.

11. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202.

Regarding claim 11, claim 9 of the U.S. Patent No. 6,658,202 cite the features of claim 11 of this application including for use in transferring data between a removable flash memory module and a user's computer, a portable, hand-held, general purpose, digital data transfer and repository device embodied in a housing connectable to both a removable memory module and a user's notebook or desktop computer and which is of

a size which can be held in a user's palm, said repository device comprising a housing of a size to be held in the palm of a user's hand and including a memory insertion section for receiving a digital memory module having at least one digital data structure having a predetermined name, and including an output port for coupling said portable repository device to a user's computer, a mass storage device contained within said hand-held housing and operatively coupled to receive and store digital data from said digital memory module, said mass storage device being accessible for data transfer between said portable repository device and a user's computer, processing circuitry contained within said hand-held housing for controlling the transfer of data stored in said digital memory module to said mass storage device, said processing circuitry being operable in response to a user's actuation of said at least one user operable key to change the name of said digital data structure, an output interface, coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, said output interface being compatible with an interface of said user's computer (see lines 1-24).

Claim 11 of current application is obvious over claim 9 of U.S. Patent No. 6,658,202 because claim 11 of current application is broader than claim 9 of U.S. Patent No. 6,658,202. Allowance of claim 11 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 9, therefore obviousness type double patenting is appropriate.

12. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202 in view of Yamauchi et al (US 6.020.982).

Regarding claim 12, claim 9 of the U.S. Patent No. 6,658,202 fail to cite the features of claim 12 of this application including wherein said at least one user operable key permits a user to associate text information with an identified image.

Yamauchi et al teach an image data processing apparatus for converting an optical image taken by a camera into digital image data, and recording and reproducing on a recording medium, wherein during the text insertion processing function the original image is processed by the CPU 625, and the header data in image is displayed (see col.53, line 27-40 and col.54, lines 37-55). Here, Yamauchi et al discloses wherein text information is associated with an identified image by the CPU 625. Yamauchi fails to explicitly teach wherein the user (manually) associates text information with an identified image. Official Notice is taken that it is well known for a user to associate text information with an identified image, in order, for example, to assign a name or a title to an identified image.

It, therefore, would have been obvious to add wherein the user is able to associate text information with an identified image in claim 9 in order, for example, to assign a name or a title to an identified image.

13. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202 in view of Yamauchi et al (US 6.020.982).

Regarding claim 13, claim 9 of the U.S. Patent No. 6,658,202 fail to cite the features of claim 13 of this application including wherein said digital data structure is a file and the user is able to change the name of the file. Yamauchi et al teach an image data processing apparatus for converting an optical image taken by a camera into digital image data, and recording and reproducing on a recording medium, wherein by transferring the digital voice data to the data memory, when the voice reproduction start is instructed by the CPU after reproducing and displaying the image data, the content of the data memory is automatically read out and reproduced in voice, after a specified time preset by the CPU. Meanwhile, if the necessary voice file name and the voice start time are coexistent as the information of image data file, a series of processing may be done automatically by the CPU in the midst of the operation for displaying the image data (see col.44, lines 14-27). Further, Yamauchi et al teach wherein the CPU changes the screen of display 1 to V14, the menu level to "3", and the menu mode name to "position" (see col.54, lines 17-36). Since the CPU can create these changes, it would have been obvious that the CPU could make more changes, including changing the voice file name, for example. Yamauchi et al here discloses data files and automatic changing of file name, for example. Yamauchi fails to explicitly teach wherein the user (manually) changing file name, for example. Official Notice is taken that it is well known

for a user to change file name, in order, for example, to satisfy a specific engineering design consideration.

It, therefore, would have been obvious to add wherein the user is able to change the name of a file to claim 9 in order to satisfy a specific design consideration, for example.

14. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202 in view of Yamauchi et al (US 6.020.982).

Regarding claim 14, claim 9 of the U.S. Patent No. 6,658,202 fail to cite the features of claim 14 of this application including wherein said at least one user operable key permits a user to enter data for creating a directory. Yamauchi et al teach an image data processing apparatus for converting an optical image taken by a camera into digital image data, and recording and reproducing on a recording medium, wherein directory area are composed in which cluster numbers to start each packets from 1 to 1024 are recorded, for example. It follows then that a directory can be created to store a "list" of information for easy access. It would have been obvious to add creating a directory to claim 9 in order to store a list of data for easy access, for example.

15. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202.

Regarding claim 15, claim 9 of the U.S. Patent No. 6,658,202 fail to cite the features of claim 14 of this application including wherein said at least one user operable key permits a user to enter data indicative of where data is to be removed. But this would have been an obvious engineering design consideration depending on the circuit at hand.

16. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202.

Regarding claim 16, claim 9 of the U.S. Patent No. 6,658,202 cite the features of claim 16 of this application including a display device for displaying picture image data, wherein said data repository device is operable to receive digital image data from a user's computer (lines 1-4).

Claim 16 of current application is obvious over claim 9 of U.S. Patent No. 6,658,202 because claim 16 of current application is broader than claim 9 of U.S. Patent No. 6,658,202. Allowance of claim 16 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 9, therefore obviousness type double patenting is appropriate.

17. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,658,202.

Regarding claim 17, claim 9 of the U.S. Patent No. 6,658,202 cite the features of claim 17 of this application including wherein said digital memory module stores audio data (wherein data includes audio and image/video (lines 1-2).

Claim 17 of current application is obvious over claim 9 of U.S. Patent No. 6,658,202 because claim 17 of current application is broader than claim 9 of U.S. Patent No. 6,658,202. Allowance of claim 17 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 9, therefore obviousness type double patenting is appropriate.

18. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,658,202.

Regarding claim 18, claim 10 of the U.S. Patent No. 6,658,202 cite the features of claim 18 of this application including wherein said processing circuitry is operable to reformat a memory module inserted into one of the memory input ports to place the memory module into a state where it can be reused (lines 1-4).

Claim 18 of current application is obvious over claim 10 of U.S. Patent No. 6,658,202 because claim 18 of current application is broader than claim 10 of U.S. Patent No. 6,658,202. Allowance of claim 18 would result in an unjustified time-wise extension of the monopoly previously granted for the invention defined by patent claim 10, therefore obviousness type double patenting is appropriate.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saito et al teach an electronic still camera which uses a memory card, and an image signal processing apparatus which comprises a laptop computer which uses the electronic still camera and the memory card, a personal data terminal (PDA), and a host computer such as an electronic notebook.

Enasley et al (US 6,005,613) teach the field of electronic photography, including a digital camera capable of interfacing with a computer.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

COO

8/19/07.

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